

**REMARKS**

In the last Office Action, the Examiner took the following actions:

- (a) rejected claims 1, 2, 5-7, 13-15, 18, 20, 21, 30, 31, 34, 35, and 39-41 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,480,410 to Cuschieri et al. ("Cuschieri");
- (b) rejected claims 8-12 and 14 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,261,883 to Hood et al. ("Hood"); and
- (c) rejected claims 1-7, 20-24, 26-35, and 38-41 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,906,577 to Beane et al. ("Beane") in view of Cuschieri.

By this Amendment, Applicant proposes to amend claims 1, 3, and 39.

Accordingly, upon entry of Applicant's proposed claim changes, claims 1-15, 17-24, 26-35, and 38-41 will remain pending in this application. Of those pending claims, claims 17 and 19 were previously withdrawn.

Applicant submits that the claims, including amended claims 1, 3, and 39 read on the elected species of Figs. 58(a)-60(c). Applicant also submits that support for the amended claims can be found in at least Figs. 58(a)-60(c) of Applicant's drawings, and in page 24, lines 13-26 of Applicant's specification. No new matter is introduced by this Amendment.

**I. Rejection under 35 U.S.C. § 102(b) based on Cuschieri**

In light of the amendment to independent claims 1 and 39, Applicant respectfully requests the reconsideration of the rejection of claims 1, 2, 5-7, 13-15, 18, 20, 21, 30, 31, 34, 35, and 39-41 under 35 U.S.C. § 102(b) as allegedly being anticipated by Cuschieri. Cuschieri fails to teach or suggest each and every element recited in those claims.

Amended independent claim 1 recites, *inter alia*, “a spring-loaded mounting element.” Cuschieri fails to teach or suggest at least this recited feature of claim 1.

Cuschieri discloses a medical device. That device includes one or more iris valves 11, shown in Figs. 1 and 5. As described in Cuschieri,

... the access opening comprises one or more iris valves 11 constructed from a pair of rings 12 fixed or rotatable with respect to each other and connected to opposite ends of a tube 13 . . .

The iris valve 11 may also be an adjustable valve 15 . . . the valve 15 can include an inner ring 16 which rotates relative to a fixed outer ring 17, the rings being separated by one or more gears 18, as shown in FIGS. 4a-b.

Cuschieri, column 4, lines 15-18, 27, 28, and 42-45. But neither pair of rings 12, inner ring 16, nor outer ring 17 is spring-loaded. Cuschieri does not even mention such a feature. Thus, Cuschieri fails to teach or even suggest “a spring-loaded mounting element,” as recited in amended independent claim 1. Accordingly, withdrawal of the rejection and the allowance of claim 1 is respectfully requested.

Amended independent claim 39 recites, *inter alia*, “a mounting element including a biasing element . . . the biasing element biasing the sealing member to close the access opening.” No such biasing element is disclosed on inner ring 16 or outer ring 17 of Cuschieri. Cuschieri does not even mention such a feature. Thus, Cuschieri fails to teach or even suggest, “a mounting element including a biasing element . . . the biasing element biasing the sealing member to close the access opening,” as recited in amended independent claim 39. Accordingly, withdrawal of the rejection and the allowance of claim 39 is respectfully requested.

Claims 2, 5-7, 13-15, 18, 20, 21, 30, 31, 34, 35, 40, and 41 depend from one of amended independent claims 1 and 39, and are allowable for at least the reasons

stated above for claims 1 and 39. In addition, claims 2, 5-7, 13-15, 18, 20, 21, 30, 31, 34, 35, 40, and 41 recite unique limitations and combinations that are neither taught nor suggested by the cited art, and therefore are also separately patentable.

**II. Rejection under 35 U.S.C. § 102(b) based on Hood**

Applicant respectfully requests reconsideration of the rejection of claims 8-12 and 14 under 35 U.S.C. § 102(b) as allegedly being anticipated by Hood. The statement of rejection on page 2 of the Office Action asserts that

Hood et al. discloses a surgical device including: a mounting element with a first ring element 66 and a second ring element 36; a twisted sealing member 40 having a normally closed access opening; and a spring element 81 . . . (Figs. 9-10, col. 4, lines 31-68, col. 5 and col. 6, lines 1-17).

Applicant submits that Hood has been cited in error in the Office Action. Reference numeral 36 corresponds to an opening in Hood, not a second ring element, as asserted in the Office Action. See Hood, column 4, line 48. Reference numeral 40 corresponds to an insulating sleeve, not a twisted sealing member. See Id. at column 4, line . Reference numeral 66 corresponds to a fluid passageway, not a first ring element. See Id. at column 5, line 17. Moreover, Hood does not even include a reference numeral 81, a Fig. 9, or a Fig. 10, which are cited in the Office Action as forming the basis for the rejection. For all of these reasons, Applicant submits that the rejection of claims 8-12 and 14 based on Hood is improper and should be withdrawn. The timely allowance of claims 8-12 and 14 is respectfully requested.

**III. Rejection under 35 U.S.C. § 103(a) based on Beane in view of Cuschieri**

In light of the amendment to independent claims 1 and 39, Applicant respectfully requests reconsideration of the rejection of claims 1-7, 20-24, 26-35, and 38-41 under

35 U.S.C. § 103(a) as allegedly being unpatentable over Beane in view of Cuschieri.

Beane and Cuschieri, regardless of whether they are viewed individually or in combination, fail to disclose or render obvious all of the subject matter recited in those claims.

Beane discloses various devices, including a surgical access port 62 shown in Fig. 1, a wound retractor 200 and a sealing sleeve 202 shown in Fig. 5, a sealing sleeve with an iris valve 76 shown in Figs. 6A and 6B. See Beane, column 5, line 43; column 9, lines 7-9 and 29-31. But Beane is deficient at least because Beane does not teach or even suggest “a spring-loaded mounting element,” as recited in amended independent claim 1, or “a mounting element including a biasing element . . . the biasing element biasing the sealing member to close the access opening,” as recited in amended independent claim 39. Moreover, for at least the reasons stated above in the discussion of the § 102(b) rejection based on Cuschieri, Cuschieri does not remedy the above-noted deficiencies of Beane. Thus, Beane and Cuschieri, regardless of whether they are viewed individually or in combination, fail to disclose or render obvious all of the subject matter recited in claims 1 and 39. Withdrawal of the rejection, along with the timely allowance of claims 1 and 39, is respectfully requested.

Claims 2-7, 20-24, 26-35, 38, 40, and 41 depend from one of amended independent claims 1 and 39, and are allowable for at least the reasons stated above for claims 1 and 39. In addition, claims 2-7, 20-24, 26-35, 38, 40, and 41 recite unique limitations and combinations that are neither taught nor suggested by the cited art, and therefore are also separately patentable.

**IV. Request for Rejoinder**

Applicant respectfully requests that previously withdrawn claims 17 and 19 be rejoined with the elected claims in this application upon entry of Applicant's proposed claim changes. Claims 17 and 19 depend either directly or indirectly from amended independent claim 1, and thus, are allowable for at least the same reasons that amended independent claim 1 is allowable. In addition, each of these withdrawn dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

**Conclusion**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-15, 17-24, 26-35, and 38-41 in condition for allowance. Applicant submits that the proposed amendments of independent claims 1 and 39 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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